



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,223	09/28/2001	James B. Kargman	2002052	5896

34018 7590 12/22/2004

GREENBERG TRAURIG, LLP  
77 WEST WACKER DRIVE  
SUITE 2500  
CHICAGO, IL 60601-1732

EXAMINER

BACKER, FIRMIN

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/966,223	Applicant(s) KARGMAN, JAMES B.	
	Examiner Firmin Backer	Art Unit 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

This is in response to an amendment file on October 8<sup>th</sup>, 2004. In the amendment, claims 5, 15-17, 19-24, 26-36, 38, 39 have been amended, no claim has been canceled, and no claim has been added. Claims 1-39 remain pending in the letter.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Niwa (U.S. PG Pub No. 2002/0188574).

3. As per claims 1, Niwa teaches a method of electronically executing a commercial transaction between a customer and a vendor, the method comprising transmitting electronically a transaction code from the customer to an electronic order processing system associated with the vendor; receiving the transaction code by the order processing system associated with the vendor; identifying the user based upon the contents of the transaction code; authenticating the transaction code; identifying a commercial transaction associated with the transaction code; and

Art Unit: 3621

executing the identified commercial transaction (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

4. As per claims 2, Niwa teaches a method of transmitting a transaction code is comprised applying the transaction code dial sequence to a line associated with a public switched telephone network (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

5. As per claims 3, Niwa teaches a method in which the transaction code is comprised of a Universal Resource Locator, and the transaction code is transmitted via the Internet (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

6. As per claims 4, Niwa teaches a method transmitting a transaction code that has been previously stored within digital memory associated with a wireless telephone via a wireless communications network (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

7. As per claims 5, Niwa teaches a method of identifying the contents of a user identification data field within the transaction code; locating the user identification data field contents within a database accessible by the order processing system (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

8. As per claims 6, Niwa teaches a method of: identifying the contents of a security code field within the transaction code; determining that the received transaction code is authentic

Art Unit: 3621

when the contents of the security code field correspond to a previously-configured security code associated with the contents of the user identification data field, which previously-configured security code is stored within a database accessible by the order processing system (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

9. As per claims 7, Niwa teaches a method of: identifying a decryption key associated with the contents of the user identification data field; decrypting at least a portion of the transaction code using the identified decryption key; determining whether the decrypted portion of the transaction code is valid (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

10. As per claims 8, Niwa teaches a method of: identifying a decryption key based upon the identity of the user; decrypting at least a portion of the transaction code using the decryption key (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

11. As per claims 9, Niwa teaches a method of: determining the contents of a transaction identification field within the transaction code; locating the contents of the transaction identification field within a database accessible by the order processing system; identifying the nature of the commercial transaction based upon information within the database associated with the contents of the transaction identification field (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

Art Unit: 3621

12. As per claims 10, Niwa teaches a method of: determining the contents of a transaction identification field within the transaction code; identifying the nature of the commercial transaction based upon information within the transaction identification field (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

13. As per claims 11, Niwa teaches a method of: locating a record within a database associated with the order processing system based upon the identity of the user; retrieving details of the commercial transaction from the database record associated with the user (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

14. As per claims 12, Niwa teaches a method in which the database is maintained within a point of sale computer system operated by the vendor (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

15. As per claims 13, Niwa teaches a method of entering the identified commercial transaction into a point of sale computer system operated by the vendor (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

16. As per claims 14, Niwa teaches a method of electronically executing a commercial transaction between a customer and a vendor, the method comprising the steps of: dialing a transaction code comprised of a telephone dial sequence onto a telephone network directed to an order processing system associated with the vendor; receiving a telephone call by the order

Art Unit: 3621

processing system as a result of the dialing of the transaction code; detecting caller identification information received by the order processing system from the telephone network in conjunction with the telephone call; detecting at least a portion of the transaction code dial sequence by the order processing system associated with the vendor; identifying the user based upon the caller identification information received by the order processing system; identifying a commercial transaction associated with the transaction code; and executing the identified commercial transaction (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

17. As per claims 15, Niwa teaches a method of identifying a record in a database associated with the order processing system based upon the received caller identification information; retrieving details of the commercial transaction from the database record associated with the received caller identification information (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

18. As per claims 16, Niwa teaches a method of authenticating the user before executing the identified commercial transaction (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

19. As per claims 17, Niwa teaches a method of prompting the user to enter a passcode; determining that the passcode entered corresponds to a passcode value previously stored within a database record associated with the caller identification information (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

Art Unit: 3621

20. As per claims 18, Niwa teaches a method for configuring an electronic user device for the automated execution of a commercial transaction between a customer and a vendor, the method comprising generating a transaction code comprised of encoded information associated with the commercial transaction; conveying the transaction code to the user device electronically; storing the transaction code within the user device; transmitting the transaction code by the user device to initiate the execution of the commercial transaction with which the transaction code is associated (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

21. As per claims 19, Niwa teaches a method in which the electronic device is a wireless telephone, and the transaction code is stored within telephone book memory of the wireless telephone (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

22. As per claims 20, Niwa teaches a method in which the electronic device is a wireless telephone, the transaction code is comprised of a telephone dialing sequence, and the transaction code is stored within telephone book memory of the wireless telephone (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

23. As per claims 21, Niwa teaches a method in which the transaction code is comprised of a Universal Resource Locator (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).



Art Unit: 3621

24. As per claims 22, Niwa teaches a method in which the transaction code is conveyed to the electronic device via wireless messaging (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

25. As per claims 23, Niwa teaches a method of identifying wireless message as a transaction code capable of storage within the user device; programming the transaction code into digital memory within the user device without requiring substantial intervention by the user (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

26. As per claims 24, Niwa teaches a method where the transaction code is generated by a point of sale system associated with the vendor in response to a request by the customer (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

27. As per claims 25, Niwa teaches a method for the dissemination of information to a mobile electronic user device based upon the device location, for the facilitation of a commercial transaction between a customer and a vendor, the method comprising the steps of: identifying the location of the user device; determining that the location of the user device conforms to a predetermined location criterion for receipt of a message; conveying the message to the user device electronically (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

Art Unit: 3621

28. As per claims 26, Niwa teaches a method in which the message is a transaction code which can be stored within the user device and subsequently transmitted by the user device to initiate a commercial transaction (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

29. As per claims 27, Niwa teaches a method of determining that the location of the user device lies within a predetermined geographical region associated with the vendor (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

30. As per claims 28, Niwa teaches a method of identifying the location of the user device is performed via triangulation techniques implemented by the communications infrastructure with which the cellular telephone operates (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

31. As per claims 29, Niwa teaches a method of identifying the location of the user device is performed by receiving location information provided by the global positioning system receiver (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

32. As per claims 30, Niwa teaches a method of determining that the message satisfies one or more filter criteria preconfigured by the customer (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

Art Unit: 3621

33. As per claims 31, Niwa teaches a method in which the filter criteria are satisfied when one or more of the following message attributes conform to predetermined user preferences: the identity of the vendor; the geographical location of the vendor; the zip code in which the vendor is located; the city in which the vendor is located; the nature of the business conducted by the vendor; the frequency with which the customer enters the area in which the vendor does business; and the frequency with which the customer receives messages from the vendor (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

34. As per claims 32, Niwa teaches a method of automatically deleting the transaction code from the user device upon the satisfaction of a deletion criterion (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

35. As per claims 33, Niwa teaches a method in which the deletion criterion is the expiration of a predetermined period of time since the transaction code was stored within the user device (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

36. As per claims 34, Niwa teaches a method in which the deletion criterion is the transmission of the transaction code by the user device (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

Art Unit: 3621

37. As per claims 35, Niwa teaches a method in which the deletion criterion is the transportation of the user device a predetermined distance from a location associated with the vendor (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

38. As per claims 36, Niwa teaches a method in which the message is comprised of map information identifying the location of the user device and a location associated with the vendor (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

39. As per claims 37, Niwa teaches a method for the dissemination of information to a mobile electronic user device based upon the device location, for the facilitation of a commercial transaction between a customer and a vendor, the method comprising identifying the current location of the user device; identifying the direction and rate at which the user device is moving; determining that the location, direction of travel and rate of travel of the user device conform to one or more predetermined criterion for receipt of a message; conveying the message to the user device electronically (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

40. As per claims 38, Niwa teaches a method of determining the anticipated location of the user device at a predetermined time in the future based upon the current location, rate of travel and direction of travel; determining that the anticipated location of the user lies within a predetermined region associated with the vendor (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

Art Unit: 3621

41. As per claims 39, Niwa teaches a method of calculating a radius of accessibility for the customer operating the user device as an estimate of the geographical region over which the customer would travel to engage in a commercial transaction, which calculation is based upon the location, rate of travel and direction of travel of the user device; determining that a location associated with the vendor lies within the radius of accessibility (*see paragraphs 0005-0006, 0008, 0009, 0012 0022, 0035*).

### *Conclusion*

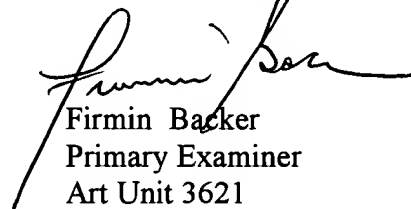
42. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



Firmin Backer  
Primary Examiner  
Art Unit 3621

December 16, 2004